UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/393,473	09/10/1999	WAYNE COHEN	A32636-07270	2770

21003 7590 01/07/2002

BAKER & BOTTS
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

EXAMINER	
HSIEH, SHIH YUNG	

ART UNIT	PAPER NUMBER
2837	

DATE MAILED: 01/07/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

NP

Office Action Summary

Application No.	Applicant(s)
09/393,473	Cohen
Examiner	**Art Unit**
Shih-yung Hsieh	2837

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *Dec 6, 2001* .

2a) ☒ This action is **FINAL.** 2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *13 and 14* is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *13 and 14* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____ .
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☐ Notice of References Cited (PTO-892)
16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
18) ☐ Interview Summary (PTO-413) Paper No(s). _____
19) ☐ Notice of Informal Patent Application (PTO-152)
20) ☐ Other:

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kralik et al. in view of Isackson (5,659,143) and Zadek (2,364,581).

Kralik et al. disclose a maraca as stated in the office action of 7/19/2000. The difference between Kralik et al's maraca and claims 13 and 14 is that the claims recite using the maraca as an ornament for a key chain, said handle is fabricated of flexible material permitting resilient bending of said handle, said ornament having the overall shape of a miniature maraca having an overall length corresponding to the approximate width of a person's hand, and a bore sized for receiving a key ring or key chain member and is formed in the distal end of the handle of the maraca.

Isackson teaches using the maraca as an ornament for a key chain, and a bore is formed in the distal end of the handle of the maraca for receiving a key chain (col. 3, last line, and col. 4, lines 1-4, and "carried in a pocket or a purse" obviously means the size of said ornament having an overall length corresponding to the approximate width of a person's hand). Zadek teaches a rattle handle (18) made of flexible material (col. 2 , line 10, and a flexible handle is obviously permitting resilient bending of said handle). It would have been obvious to a person having ordinary skill in the art to modify Kralik et al's ornament as taught by Isackson and Zadek to

include the maraca as an ornament for a key chain with a handle fabricated of flexible material, and a bore is formed in the distal end of the handle of the maraca for the purpose of receiving a key chain.

3. Applicant's arguments filed 12/6/2001 have been fully considered but they are not persuasive.

The following are the examiner's response to the applicant's Declaration stated in the applicant's remarks:

(1) the commercial success of the invention

A mere statement of commercial success and the inclusion of a product catalog in the Declaration do not establish commercial success.

An applicant who is asserting commercial success to support its contention of nonobviousness bears the burden of proof of establishing a nexus between the claimed invention and evidence of commercial success. See MPEP 716.03.

A catalog is considered as an advertisement which do not establish commercial success of market share. Further, gross sales figures do not show commercial success absent evidence as to market share. Cable electric Products. Inc. v. Genmark, Inc., 770 F.d2 1015, 226 USPQ 881 (Fed. Cir. 1985). See MPEP 716.03(b).

In this case, the applicant fails to provide sufficient evidence to demonstrate commercial success.

(2) copying the invention by others

The applicant's statement of copying the invention by others as a secondary evidence of commercial success is not sufficient. More than the mere fact of copying is necessary to make this argument persuasive. See MPEP 716.06.

(3) facts concerning the invention

In response to Applicant's argument that the inventor tried making a key chain following the teaching of the Krelik, et al. patent and resulted in failure, the test for obviousness is not whether the features of one reference may be bodily incorporated into the other to produce the claimed subject matter but simply what the combination of references makes obvious to one of ordinary skill in the pertinent art. In re Bozek, 163 USPQ 545 (CCPA 1969).

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

5. Any inquiry concerning this communication should be directed to (David) S.Y. Hsieh at telephone number (703) 308-1031.

SHIH-YUNG HSIEH
PRIMARY EXAMINER